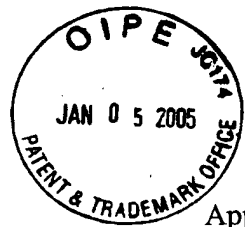


JKW



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/747,956 Confirmation No. : 6209
First Named Inventor : Ullrich SESEKE-KOYRO
Filed : December 31, 2003
TC/A.U. : 1754
Examiner : Ngoc Yen M. NGUYEN

Docket No. : 037110.51540D1
Customer No. : 23911

Title : ALKALI METAL FLUORO ZINCATE AND THE PRODUCTION
THEREOF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY

Sir:

Responsive to the Office Action dated October 5, 2004 in the above-captioned application, the provisional election of Group I, claims 8-12 is affirmed. The restriction requirement is traversed. The Office Action asserts that the process of claims 13-17 can be used with another materially different product. However, all of the claims of Group II, claims 13-17 require the product of one of claims 8, 11 or 12 (Group I). Thus, it cannot be the case that the process can be used to make another materially different product. For instance, claim 13 specifically depends from claim 8 and can only be practiced with the product of claim 8. Similarly, claim 15 depends from claim 11 and claim 16 depends from claim 12. The remaining claims in Group II are also dependant. Accordingly, it is not possible to practice the processes of Group II with any product other than those recited in Group I.

The MPEP requires that either the claimed process can be used to make other and different product or that the product as claimed can be made by another and materially different process. MPEP 806.05(f). As explained above, the process claims are directed to the products of Group I. Further, there is no suggestion in the present record that the product can be made by another, materially different process. For this reason, the restriction requirement cannot be properly maintained. Reconsideration and withdrawal of the restriction requirement are respectfully requested.

On page 2, the Office Action indicates that U.S. Patent No. 6,432,221 describes a product which is "materially different" from that of claims 8-12 of the present patent application. The WO 99/48641 application is the parent application of U.S. 6,432,221. Thus, the Office Action appears to assert that U.S. 6,432,221 is directed to a materially different product, while the parent application of that U.S. patent, WO 99/48641, is cited in the obviousness rejections of the Office Action. In the event that the Examiner maintains the pending rejections, the Examiner is respectfully requested to clarify how the same disclosure can be both "materially different" from the claimed product and also serve as the basis for an obviousness rejection.

The rejection of claims 8-11 under 35 U.S.C. § 103(a) as obvious over WO 99/48641 or Lauzon et al. (U.S. Patent No. 6,105,850) in view of Popoola et al. (U.S. Patent No. 5,723,187) is respectfully traversed.

In the present application, claim 8 recites a fine alkali metal fluorozincate with a grain spectrum in which 50% of the particles have a diameter of $< 5 \mu\text{m}$. Claim 9 depends from claim 8 and adds that the alkali metal is potassium. Claim 10 requires a fluorozincate with a grain spectrum in which 50% of the particles have a diameter of $< 3.8 \mu\text{m}$. Claim 11 requires a fluorozincate with a grain spectrum in which 50% of the particles have a diameter of $< 11 \mu\text{m}$. As indicated on page 4 of the Office Action, neither WO '641 nor Lauzon teaches a particle size for the metal fluorozincate. Popoola teaches a thermal spray coating using potassium aluminum fluorides with a particle size under $10 \mu\text{m}$. There is no teaching or suggestion in Popoola to try to achieve a fluorozincate with a grain spectrum in which 50% of the particles have a particle size of less than $5 \mu\text{m}$, much less one with a particle size of less than $3.8 \mu\text{m}$. Similarly the references do not teach a fluorozincate with a grain spectrum in which 50% of the particles have a diameter of $< 11 \mu\text{m}$. Further, the references do not teach whether such fluorozincates are usable or how they can be made. Accordingly, the references fail to teach each and every element of the claimed invention.

Not only do the cited references fail to teach the elements of the claimed invention, one of skill in the art would have no motivation to try to combine the cited references. The mere fact that the references can be combined does not render the resultant combination

obvious unless the prior art also suggests the desirability of the combination. In *re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). Absent some teaching, suggestion or incentive to combine the references, obviousness cannot be established. In *re Geiger*, 815 F.2d 686, 688, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987). Indeed, to make proper showing of obviousness, the MPEP requires a suggestion or motivation to combine the references. MPEP § 706.02(j) (Eighth Edition, Revision 2, May 2004). Because of the lack of any such motivation or suggestion, and the failure of the references to teach all of the elements of the claims, the obviousness rejection cannot be properly maintained. Reconsideration and withdrawal thereof are respectfully requested.

The rejection of claim 12 under 35 U.S.C. § 103(a) as obvious over WO 99/48641 or Lauzon et al. (U.S. Patent No. 6,105,850) in view of Shimajiri et al. (U.S. Patent No. 4,989,775) is respectfully traversed.

Claim 12 recites a fine alkali metal fluorozincate with a grain spectrum in which 50% of the particles have a diameter of $> 11 \mu\text{m}$. Again, the Office Action indicates that neither WO '641 nor Lauzon teaches a particle size for the metal fluorozincate. Shimajiri teaches a method for soldering aluminum using potassium fluoroaluminate where the grain size of the particles is from 6 to 75 μm . Shimajiri does not teach alkali metal fluorozincates or whether they are usable or how they can be made. Even further, one of skill in the art would not assume and would have no reason to assume that the particle sizes taught by Shimajiri would be valid for all fluxes, regardless of their composition and manufacture. Thus, the cited references fail to teach all of elements of claim 12.

Not only do the cited references fail to teach the elements of claim 12, one of skill in the art would have no motivation to try to combine the cited references. The mere fact that the references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In *re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). Absent some teaching, suggestion or incentive to combine the references, obviousness cannot be established. In *re Geiger*, 815 F.2d 686, 688, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987). Indeed, to make proper showing of obviousness, the MPEP requires a suggestion or motivation to combine the references. MPEP § 706.02(j) (Eighth

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Response to Office Action dated October 5, 2004

Edition, Revision 2, May 2004). Although WO '641 and Lauzon teach a metal fluorozincate, Shimarjiri teaches a metal fluoroaluminate. Given this difference, one of skill in the art would have no reason to look to Shimarjiri for teachings relevant to the metal fluorozincate of WO '641 and Lauzon. Because of the lack of any such motivation or suggestion, and the failure of the references to teach all of the elements of the claim, the obviousness rejection cannot be properly maintained. Reconsideration and withdrawal thereof are respectfully requested.

CONCLUSION

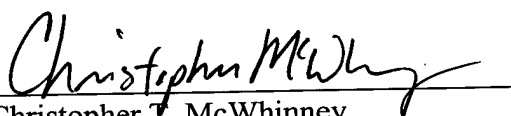
In view of the foregoing, the application is respectfully submitted to be in condition for allowance, and prompt favorable action thereon is earnestly solicited.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #037110.51540D1).

Respectfully submitted,

January 5, 2005


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